

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Mark S. Young)	Petitions
)	Examiner:
Serial No.	:	09/738,003)	Alesia M. Brown
)	
Cnfrm. No.	:	1404)	Art Unit:
)	2186
Filed	:	December 14, 2000)	
)	
For	:	ARBITRATION AND CROSSBAR DEVICE)	
		AND METHOD)	

RENEWED PETITION UNDER 37 CFR 1.137(b)

Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Petitioners respectfully request reconsideration of the decision to dismiss the "Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" submitted by Petitioners on June 1, 2007. This petition included: (1) an Amendment to the outstanding Office Action for the above-identified application; (2) the petition fee; (3) a statement that the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional; and (4) noted that no terminal disclaimer was required. In the decision on this petition, the Office asserted the petition lacked item (3). More specifically, the Office asserted there are three periods to be considered during the evaluation of a petition under 37 C.F.R. 1.137(b):

- (1) the delay in reply that originally resulted in the abandonment;
- (2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application; and
- (3) the delay in filing a grantable petition pursuant to 37 CFR 1.137(b) to review the application.

The Office asserts the delay has not yet been shown to the satisfaction of the Director to be unintentional for periods (1) and (2) above.

Accordingly, accompanying this renewed petition is a “Declaration of John Campa,” which provides the requested additional information showing the delay in periods (1) and (2) above was unintentional. Additionally, Applicant notes the Office of Petitions has previously granted Applicant’s Petitions For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b) for US Patent Application Serial No. 09/273,238 and US Patent Application Serial No. 09/272,807, which were part of the same asset purchase agreement and were unintentionally abandoned under similar circumstances. In view of the previously submitted petition and this declaration, Petitioners respectfully request the Office to reconsider and revive the above-identified patent application.

The U.S. Patent and Trademark Office is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 14-1138

Respectfully submitted,

Date: October 10, 2008

/Gunnar G. Leinberg/
Gunnar G. Leinberg
Registration No. 35,584

NIXON PEABODY LLP
1100 Clinton Square
Rochester, New York 14604
Telephone: (585) 263-1014
Facsimile: (585) 263-1600

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DECLARATION OF JOHN CAMPA

MAIL STOP PETITIONS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I, JOHN CAMPA, declare:

1. I currently am Intellectual Property Counsel and the only registered patent attorney at F5 Networks, Inc. (F5).
2. I started at F5 on June 5, 2006, replacing Gary Mager, a registered patent attorney, who only worked part time at F5 at the time of his departure. Mr. Mager left F5 in early March or April 2006 prior to my arrival.
3. One of my tasks as F5's Intellectual Property Counsel is to assist with the oversight, management, and development of F5's intellectual property portfolio.
4. Shortly after my June 2006 start date, I began an investigation to identify and organize F5's existing intellectual property portfolio. In view of the state of the files related to F5's intellectual property portfolio that I inherited, this investigation took some time to complete.
5. During this investigation, I came across the above-identified patent application which was assigned to F5 and was now abandoned, but had no accompanying instructions to allow this to occur. Accordingly, I prepared a memorandum for consideration by F5's patent committee to investigate the circumstances behind this, including determining whether the

abandonment of the above-identified patent application may have been either unavoidable or unintentional (Exhibit A). While I cannot recall the exact date I began preparation of the Exhibit A memorandum, the metadata of the Word file indicates that the last date the file was edited was August 16, 2006.

6. F5's patent committee is made up of senior members of F5's product development corps, which includes F5's Chief Technical Officer, Karl Triebes. Further, the patent committee members have no experience or training on how to monitor and manage the status of pending patent applications which was one of the factors leading to my hire.

7. At a patent committee meeting on or about August 17, 2006, I inquired into the circumstances behind the abandonment of the above-identified patent application. Based on this inquiry, the patent committee members informed me the above-identified patent application was acquired from uRoam, Inc. (uRoam), in connection with an asset purchase agreement where other uRoam intellectual property assets were purchased. Additionally, it was my understanding the patent committee members were unaware the patent application was ever even abandoned and simply thought the application they purchased was currently pending. The patent committee was used to long delays in pending matters at the US Patent and Trademark Office and therefore did not have any reason to question their understanding or the status of this patent application. Further, upon learning its current status, the patent committee members reaffirmed their continued intent to have the above-identified patent revived and pending. Accordingly, based on these discussions it appeared this application was unintentionally abandoned.

8. Following this patent committee meeting, I researched further and was able to locate a seller disclosure letter dated July 23, 2003, where F5 purchased the above-identified patent application. A copy of pages 1 and 26 of this letter are attached as Exhibit B. As set forth in Schedule 3.25(d) on page 26 of this letter, the above-identified patent application identified a docket date of June 24, 2003, for responding to an outstanding office action with a note to respond no later than September 24, 2003, to avoid abandonment. Accordingly, in my opinion the inclusion of the above-identified patent application in this seller disclosure letter as part of the Asset Purchase Agreement along with the noted docketing deadlines evidences clear intent on the part of F5's to obtain and pursue the invention in the above-identified patent application. Subsequently, as noted in paragraph 5 the above-identified

patent application went abandoned, but with no accompanying instructions to allow this to occur and with no knowledge or intention for this to occur as noted in paragraph 7.

9. My subsequent investigation also revealed a communication between Mr. Mager and John Branch of the law firm Darby & Darby, who was outside counsel for F5 at the this time, about the possibility of reviving the above-identified patent. Accordingly, I contacted Mr. Branch to investigate further.

10. Based on my conversation with Mr. Branch, his recollection was Mr. Mager instructed him not to attempt to revive the above-identified patent application. However, despite my questioning he had no corresponding record in his file or docketing system provided to me to support this recollection. In my professional experience as a patent attorney, the absence of such a record in the file and docketing system does not comport with recognized practice to specifically document such an instruction to abandon a matter from a client. Accordingly, its absence caused me to question his recollection and motivated me to investigate this matter further.

11. I also attempted to reach Mr. Mager by telephone and email to discuss this matter, but was unable to reach him during this time period. I also went back and again thoroughly researched and reviewed all available files I could locate relating to this matter and still could not find a record of any such instruction in F5's files from Mr. Mager to Mr. Branch.

12. Around the next patent committee meeting on or about August 17, 2006, I again reached out and spoke to Mr. Branch about the above-identified patent application. Despite my research, which showed an absence of any documented instruction to abandon this application, Mr. Branch advised me against attempting to revive the above-identified patent application because he believed there was a low probability of success, again, the reason he originally stated why Mr. Mager did not instruct him to revive the application.

13. Subsequently, I contacted Gunnar G. Leinberg of the law firm of Nixon Peabody and requested his counsel and opinion on reviving this (and other) patent applications that went abandoned under the same circumstances, one of which the USPTO has already granted petitions to revive as mentioned above. Following our conversation, I followed up a confirmation e-mail requesting Mr. Leinberg to assist us in our analysis and, if appropriate, subsequent preparation of petitions to revive these unintentionally abandoned

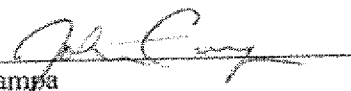
patent applications (Exhibit C).

14. With my assistance, Mr. Leinberg began his review of my investigation of the status of the above-identified patent application as described herein. After completing this review, it is my understanding Mr. Leinberg was in agreement with my conclusion the above-identified patent application appeared to be unintentionally abandoned. Accordingly, it is my understanding Jessica Egner, an associate at the law firm of Nixon Peabody, was then instructed to begin work on preparing the petition for revival of this unintentionally abandoned patent application. As part of this petition, a response to the outstanding office action was required. Ms. Egner was not familiar with the above-identified patent application and thus required time to familiarize herself with the application, outstanding office action, and cited references to be able to prepare a response. During this time, I assisted as needed for the preparation of this petition and response.

15. On or about June 1, 2007, the petition for revival of an application for patent unintentionally abandoned along with an amendment in response to the office action was filed with the US Patent and Trademark Office.

16. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,


John Campa
Intellectual Property Counsel
F5 Networks, Inc.
401 Elliot Avenue West
Seattle, WA 98119

LIST OF EXHIBITS

- A. Memorandum for the patent committee's consideration prepared by John Campa
- B. Pages 1 and 26 of Seller Disclosure Letter
- C. January 17, 2007 email from John Campa to Gunnar Leinberg

F5 Matter	Filing Date	Title
		REDACTED
10.220	12/14/2000	ARBITRATION AND CROSSBAR DEVICE AND METHOD
		REDACTED

BASIC ISSUES

We *may* be able to 'revive' the 'abandoned' patent applications referenced in the table above, but there are several challenges based on the particular circumstances in each case.

By 'abandoned,' they were patent applications filed with the USPTO and at some point uRoam simply did not respond to a USPTO communication for which there was a deadline. By 'revive,' we can file petitions, pay governmental fees and submit statements of fact to the USPTO to get these applications reinstated to a pending status on track for possible issuance as a US patent owned by F5.

While we *may* be able to 'revive' these applications so we can try to get patents to issue based on them, we should at least consider whether it makes sense for us from a business/technology view based on the technology covered in each one. As far as costs/expenses related to reviving them, the work would be done in-house and the only other costs involved would be the revival petition fees at about \$1,000 each or approximately \$3,000+/- for all three cases.

REDACTED

10.220 - Arbitration And Crossbar Device

This patent application is directed to monitoring data transfers to memory from multiple devices through arbitration and crossbar functional units and assigning a priority to each device corresponding to the amount of data transfers generated by a particular device. The crossbar unit provides a data path from each device to the memory. An arbitration unit monitors the data traffic through the crossbar and assigns the priority based on the data traffic. The application includes 20 claims, of which claims 1, 19, and 20 are independent claims. Claim 1, for example, recites:

1. An apparatus comprising:
 - a memory;
 - a plurality of functional units that transfer data to and from the memory;
 - a crossbar that provides a data path from each unit to the memory, wherein the crossbar comprises an arbitration unit to monitor data traffic generated by each of the plurality of functional units through the crossbar and assigns a priority to each functional unit based on the data traffic.

REDACTED

SELLER DISCLOSURE LETTER

uRoam, Inc.
757 North Pastoria Avenue
Sunnyvale, CA 94085

July 23, 2003

F5 Networks, Inc.
401 Elliott Avenue West
Seattle, WA 98119

Seller Disclosure Letter

Gentlemen:

This Disclosure Letter is made and given pursuant to Section 3 of the Asset Purchase Agreement dated as of July 23, 2003 (the "Agreement"), by and among F5 Networks, Inc. ("Buyer"), uRoam, Inc. ("uRoam, Inc."), and uRoam Acquisition Corp. ("UAC" and together with uRoam, Inc., "Seller"). As the context requires "Seller" shall mean either (i) uRoam, Inc. alone, or (ii) UAC alone or (iii) uRoam, Inc. and UAC together. All capitalized terms used but not defined herein shall have the meanings as defined in the Agreement, unless otherwise provided. The term "Schedule" in this Disclosure Letter shall also be understood to refer to the applicable "Part" as defined in the Agreement. The Schedule numbers below correspond to the section numbers of the representations and warranties in the Agreement; provided, however, that any information disclosed herein under any Schedule number shall be deemed to be disclosed and incorporated into any other applicable section or Part under the Agreement.

Nothing in this Disclosure Letter is intended to broaden the scope of any representation or warranty contained in the Asset Purchase Agreement or to create any covenant. Inclusion of any item in this Disclosure Letter does not represent a determination that such item is material or establish a standard of materiality. The information contained herein is disclosed solely for the purposes of the Agreement, and no information contained herein shall be deemed to be an admission by any party hereto to any third party of any matter whatsoever, including without limitation, any violation of law or breach of any agreement. The information contained in this Disclosure Letter is confidential, proprietary information of Seller, and the other parties to the Agreement shall be obligated to maintain and protect such confidential information.

The representations and warranties of Seller in the Agreement are qualified in their entirety by the financial statements provided by Seller to Buyer.

REDACTED

Schedule 3.25 (d)

Patents

1. P001 - Arbitration and Crossbar Device and Method - App. No. 09/738,003, OA received - Resp. due 6/24/03 (will go abandoned if not responded to by 9/24/03).

REDACTED

REDACTED

REDACTED

REDACTED

Leinberg, Gunnar

From: John Campa [J.Campa@F5.com]
Sent: Wednesday, January 17, 2007 7:00 PM
To: Leinberg, Gunnar
Subject: F5 Matter Nos.: 10.220; 10.230; 10.240 - Potential Petition to Revive Filings and Related Prosecution
Attachments: James Goodwin.vcf

Gunnar,

Remember we discussed three patent applications F5 obtained from a relatively recent acquisition, which were acquired in abandoned status?

If possible, could you please investigate whether we have a reasonable chance of being able to revive any of these applications (e.g., talk to a petitions attny if possible, etc), and if there is, prepare and file the petitions to revive + any outstanding office actions that might have been due in each matter?

I believe some of the inventors and/or former employees of the company that was acquired are employed by F5. Also, for what it's worth, from what I've heard from people here familiar with the acquisition and/or companies (i.e., Uroam/Filanet), they had a very informal IP department, and I do not think they had an in-house patent or IP attorney.

Also, there is a current F5 employee, James Goodwin in San Jose, who is familiar with this company and/or the acquisition. I've attached his contact info.

Also, I've pasted additional info below, and I think the file wrapper is accessible via public PAIR (let me know otherwise since I have electronic copies of the file histories here):

F5Matter No	Title				Description
10.220	Arbitration And Crossbar Device (Former Uroam)		Abandoned		Acquired in Abandoned Status. Investigate chances of reviving this matter, and if reasonable file Petition to Revive.
	REDACTED				
	REDACTED				

Thanks,

John

John Campa | Intellectual Property Attorney

Direct No.: 206.272.6327 Fax: 206.272.5602
 F5 Main No.: 206.272.5555 Cell: 206.321.4072

12/28/2007



THE WORLD RUNS BETTER WITH F5

CONFIDENTIALITY NOTICE. This e-mail message, and any attachments, may contain confidential and/or privileged information. If you are not the intended recipient, please notify the sender immediately and delete this email message including attachments. Thank you.

12/28/2007